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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,227	03/22/2004	Kinam Park	368-011C	1689

7590
Medicus Associates
4025 Arbor Rd.
Joplin, MO 64804

05/07/2008

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/807,227

Applicant(s)

PARK ET AL.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission(s) filed on 6-29-07 & 7-12-07 have been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(a) as being anticipated by DE-195 40 951 (corresponding to USPAT 6,136,873)(Hereon referred to as HAHNLE et al.).

HAHNLE et al. disclose preparations of superabsorbent polymeric hydrogel composite materials prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See HAHNLE et al. in its entirety). [– Note also – the following cites from USPAT 6,136,873 {for

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informational purposes only} pertaining to English language recitations of the later US equivalent – abstract, column 1 lines 12-16, column 2 line 24 et seq., column 3, column 5 line 26 et seq., column 6 lines 1-9, column 8 lines 49 et seq., column 9 lines 1-30, column 10-13, column 14 lines 1-6, and the examples -].

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of HAHNLE et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of HAHNLE et al.

The following arguments set forth previously are maintained:

Regarding applicants' claim of priority, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application {See M.P.E.P. 211.11 VI}. Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined disintegrant materials of the instant claims. Additionally, it is not seen that applicants' method claims which set forth the generically defined term "disintegrant" are adequately disclosed and/or envisioned by the 5,750,585 patents' suggestive disclosure of fillers for strengthening and/or absorbance purposes (see column 6 lines 40-51 of the 5,750,585 patent). This disclosure is not seen to adequately disclose the invention of the instant claims.

Rejection is maintained under 35 USC 102(a) for the reasons set forth above. Applicants' previous arguments from the reply received 11-29-05 relate to differences not supported by the limitations set forth in the claims and do not, therefore, serve to demonstrate distinction of their invention as claimed.

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Applicants' latest arguments and affidavit have been considered but rejection is not overcome.

The affidavit filed on 7-24-06 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited HAHNLE et al. reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the cited HAHNLE et al. reference. When considering the facts and documentary evidence in support of applicants' affidavit, it is necessary that the showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. {see also MPEP 715.07 for Facts and Documentary Evidence general requirement}. Applicants have not met the requirements of MPEP 715, and rejection is maintained.

Applicants' latest arguments and affidavit evidence have been considered. However, rejection is maintained for all of the reasons set forth above. Though the evidence provided would be sufficient if it was supportive of the invention claims. However, from review of the documentation of exhibit A, it is not clearly evident that the invention of the instant claims was reduced in this country or a NAFTA or WTO member country prior to the effective date of the cited HAHNLE et al. reference. It is not clear where support for many of the limitations of the current claims are provided for in the submitted document photocopy referred to in applicants' reply as "Exhibit A". Support for the invention now claimed either needs to be shown in Exhibit A or the missing elements need to be accounted for through affidavit evidence.

Applicants' latest arguments and declaration have been considered. However, rejection is maintained for the reasons set forth above.

The evidence provided is of no probative value in establishing that the invention as now claimed was reduced to practice in this country or a NAFTA or WTO member country prior to the effective date of the cited HAHNLE et al. reference. Evidence provided or being accounted for through affidavit evidence must show that the invention now claimed was reduced to practice in this country or a NAFTA or WTO member

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country prior to the effective date of the cited HAHNLE et al. reference. The evidence of record is not sufficient for the invention now claimed. Additionally, the Declaration Under 37 CFR 1.131 received 6-29-07 is improper in that it is not signed by the inventor(s) of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by EP-0,744,435.

EP-0,744,435 disclose preparations of superabsorbent crosslinked hydrogel composite polymer network materials which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See the abstract, page 8 line 57-page 9 line 26, page 10 lines 37-42, page 10 line 47 – page 14 line 7, and the examples, as well as, the entire document).

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of EP-0,744,435 and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the

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degree defined by applicants' claims is held to be inherent to the teachings of EP-0,744,435.

The following arguments set forth previously are maintained:

Applicants' arguments have been considered. However, rejection is maintained. EP-0,744,435 discloses materials which read on the disintegrants of applicants' claims, particularly, those materials disclosed at page 8 line 57 - page 9 line 15 & page 13 line 41 - page 14 line 2. Additionally, it is noted that even the carbonate blowing agents of EP-0,744,435 read on component (v.) of applicants' claims.


Applicants' latest arguments have been considered. However, rejection is maintained. As set forth and maintained above. Specific examples of materials have been identified which meet the disintegrant materials of applicants' claims (see again page 8 line 57 - page 9 line 15 & page 13 line 41 - page 14 line 2 and the additional note regarding carbonate blowing agents). Applicants' mere assertions that the disclosed materials do not meet the limitations of the claims does not constitute a fact based showing that the materials are, in fact, different.

Additionally, it is noted that the inorganic materials provided at page 13 lines 50-55 by their very composition have affinity to water and exhibit inherent porosity and wicking effects to the degrees claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
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